

Appl. No. 10/671,816
Reply to Office Action of January 12, 2006

Remarks

Claims 35, 37-39, 42-47, 51, 52, 55, 56 and 61-67 were pending. By way of this response, claims 35, 37-39, 42-47, 51, 52 and 66 have been amended and new claims 82-92 have been added and are directed to embodiments for which patent protection is sought. Support for the amendments to the claims and new claims can be found in the application as originally filed, and no new matter has been added. New claim 82 corresponds to claim 35 with the exception that the implant weight is recited as about 250-5000 μg , which finds support at paragraph 0055 of the present specification. New claims 83-92 correspond to claims 37-39, 42-47 and 51, respectively.

Claim 35 has been amended to delete the phrase "without an added release modifier". Thus, claim 35 is directed to an implant comprising a steroidal anti-inflammatory agent and a bioerodible copolymer. The claim does not require the presence or the absence of an added release modifier. This is consistent with the present specification, for example paragraph 0052, which makes clear that release modifiers such as those described in U.S. Patent No. 5,869,079 may be included in the implants (Emphasis added). Thus, the implants of claim 35 can include an added release modifier or not include an added release modifier. The Examiner's attention is drawn to the Examples of the present specification in which the implants produced and tested do not include an added release modifier.

Claim 35 has been amended to delete the phrase which the Examiner considers to be new matter. Such amendment is made without conceding the correctness of the Examiner's rejection, in an effort to facilitate the prosecution of the above-identified application and to obtain an allowance. Applicant

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reserves the right to seek patent protection for the previous claim 35 and any other claims supported by the above-identified application. Moreover, it should be noted that deleting the phrase "without an added release modifier" from claim 35 is a broadening amendment, rather than a narrowing amendment, and, therefore, does not trigger any prosecution estoppel based on the holdings in Festo.

In view of the above, applicant respectfully requests the Examiner to withdraw the rejections under 35 U.S.C. 112, first paragraph, set forth in paragraphs 3 and 4 of the Office Action and the rejection under 35 U.S.C. 112, second paragraph set forth in paragraph 6 of the Office Action.

Independent claims 35 has been further amended to made clear that the implant has a weight between about 500 µg and about 1100 µg and releases at least about 20% of the agent within about 20 days in vitro. Claim 52 has been amended to recite that the solid body has a weight between about 500 µg and about 1100 µg and releases at least about 30% of the agent within about 20 days in vitro.

In view of these amendments, applicant requests that the rejection of claims 35 and 52 under 35 U.S.C. 112, second paragraph, as set forth in paragraph 7 of the Office Action, be withdrawn.

Claims 37-39, 42-46 and 51 have been amended to refer to the "bioerodible" implant, as suggested by the Examiner.

Therefore, applicant requests that the rejection of claims 37-39, 42-46 and 51 under 35 U.S.C. 112, second paragraph, as set forth in paragraph 8 of the Office Action, be withdrawn.

Claim 47 has been amended to refer to the "bioerodible implant". Thus, claim 47 is now consistent with the claim on which it depends, that is claim 46.

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In view of the above, applicant requests that the rejection of claim 47 under 35 U.S.C. 112, second paragraph, as set forth in paragraph 9 of the Office Action, be withdrawn.

Claims 46 and 47 have been amended to refer to the inflammation-mediated condition. Thus, these claims are now consistent with independent claim 35 on which they depend.

In view of the above, applicant requests that the rejection of claims 46 and 47 under 35 U.S.C. 112, second paragraph, set forth in paragraph 10 of the Office Action, be withdrawn.

Independent claim 52 has been amended to recite that the solid body comprises particles of a steroidal anti-inflammatory agent entrapped within a bioerodible copolymer. This amendment is fully supported by the present specification, for example at paragraph 0089 of the specification.

In view of the above, applicant requests that the rejection of claim 52 and the dependent claims 55, 56 and 61-67 under 35 U.S.C. 112, second paragraph, as set forth in paragraph 11 of the Office Action, be withdrawn.

In addition, the above-noted amendment to independent claim 52 provides antecedent support for the term "the steroidal anti-inflammatory agent" recited in dependent claims 55, 56 and 61-63.

In view of the above, applicant requests that the rejection of claims 55, 56 and 61-63 under 35 U.S.C. 112, second paragraph, as set forth in paragraph 12 of the Office Action, be withdrawn.

Further, the amendment to claim 52 regarding reference to a bioerodible copolymer provides antecedent basis for the term "the bioerodible copolymer" in claims 64 and 65.

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In view of the above, applicant requests that the rejection of claims 64 and 65 under 35 U.S.C. 112, second paragraph, set forth in paragraph 13 of the Office Action, be withdrawn.

Claim 66 has been amended to refer to "the inflammatory-mediated condition". Thus, this phrase in claim 66 finds antecedent support in independent claim 52 from which claim 66 depends.

In view of the above, applicant requests that the rejection of claim 66 under 35 U.S.C. 112, second paragraph, set forth in paragraph 14 of the Office Action, be withdrawn.

In conclusion, applicant has shown that the present claims satisfy the requirements of 35 U.S.C. 112. Therefore, applicant submits that the present claims, that is claims 35, 37-39, 42-47, 51, 52, 55, 56, 61-67 and 82-92 are allowable, and respectfully requests the Examiner to pass the above-identified application to issuance at an early date. Should any matters remain unresolved, the Examiner is requested to call applicant's attorney at the telephone number given below.

Date: 3/24/06

Respectfully submitted,



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